

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed September 16, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(e)

Claims 1-7 and 9-22 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Walker, et al. ("Walker," U.S. Pat. No. 6,415,264). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Walker reference. Applicant discusses Applicant's claims in relation to the applied references in the following.

Independent claim 1 provides as follows (emphasis added):

1. A method for facilitating sale of a network-enabled device *that is practiced by the network-enabled device*, the method comprising:

receiving with the network-enabled device an indication of an intent *to sell the network-enabled device*; and

automatically transmitting from the network-enabled device a request to a network-based sales service to post a sale notice that offers the network-enabled device for sale on a network.

As is apparent from the above excerpt, Applicant's claim 1 describes a method for facilitating sale of a network-enabled device that is actually practiced by the network-enabled device. Therefore, in accord with Applicant's disclosure, Applicant is claiming a method in which a device facilitates its own sale.

Walker simply does not teach or suggest a method in which a network-enabled device facilitates its own sale. Instead, Walker discloses a "seller device 110" that sends a communication to a network about a *different item* to be sold. Walker, column 3, lines 55-61. Accordingly, Walker does not teach or suggest "receiving with the network-enabled device an indication of an intent to sell the network-enabled device" or "automatically transmitting from the network-enabled device a request to a network-based sales service to post a sale notice that offers the network-enabled device for sale on the network", as are required by claim 1. Claim 1 and its dependent claims are therefore allowable over Walker for at least this reason.

Independent claim 10 provides as follows (emphasis added):

10. A system for facilitating sale of a network-enabled device, the system comprising:

means *provided on the network-enabled device* for receiving indication of an intent *to sell the network-enabled device*; and

means *provided on the network-enabled device* for facilitating transmission of a request to a network-based sales service to post a sale notice that *offers the network-enabled device for sale on a network*.

As noted above in relation to claim 1, Walker does not teach or suggest a network-enabled device that facilitates its own sale. It therefore logically follows that Walker fails to teach or suggest “means provided on the network-enabled device for receiving indication of an intent to sell the network-enabled device” or “means provided on the network-enabled device for facilitating transmission of a request to a network-based sales service to post a sale notice that offers the network-enabled device for sale on a network”, as are required by claim 10. Claim 10 and its dependent claims are therefore allowable over Walker for at least this reason.

Independent claim 13 provides as follows (emphasis added):

13. ***A device sale manager stored on a computer-readable medium of a network-enabled device***, the manager comprising:

logic configured to receive an indication of an intent to ***sell the network-enabled device***; and

logic configured to facilitate transmission of a request to a network-based sales service to post a sale notice that ***offers the network-enabled device for sale on a network***.

As noted above in relation to claim 1, Walker does not teach or suggest a network-enabled device that facilitates its own sale. It therefore logically follows that Walker fails to teach or suggest a device sale manager stored on a network-enabled device that includes “logic configured to receive and an indication of an intent to sell the network-enabled device” or “logic configured to facilitate transmission of a request to a network-based sales service to post a sale notice that offers the network-enabled device for sale on a network”, as are required by claim 13. Claim 13 and its dependent claims are therefore allowable over Walker for at least this reason.

Independent claim 18 provides as follows (emphasis added):

18. A network-enabled device *that is configured to facilitate sale of itself*, the network-enabled device comprising:
a processing device; and
memory including a device sale manager, the sale manager including logic configured to *receive an indication of an intent to sell the network-enabled device*, and logic configured to *facilitate transmission of a request* to a network-based sales service to post a sale notice *that offers the network-enabled device for sale* on a network.

As noted above in relation to claim 1, Walker does not teach or suggest a network-enabled device that facilitates its own sale. It therefore logically follows that Walker fails to teach or suggest a network-enabled device “that is configured to facilitate sale of itself” and comprises a device sale manager including logic configured to “receive an indication of an intent to sell the network-enabled device” and “facilitate transmission of a request to a network-based sales service to post a sale notice that offers the network-enabled device for sale on a network”, as are required by claim 18. Claim 18 and its dependent claims are therefore allowable over Walker for at least this reason.

Due to the above-described shortcomings of the Walker reference described in the foregoing, Applicant respectfully asserts that Walker does not anticipate Applicant’s claims. Therefore, Applicant respectfully requests that the rejection be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

Claim 8 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Woolston (U.S. Pat. No. 6,085,176). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

As is identified above in reference to independent claim 1, Walker does not teach or suggest a network-enabled device that facilitates its own sale. In that Woolston

does not remedy this deficiency of the Walker reference, the rejection fails to teach or suggest all the claim limitations as is required by MPEP section 2143.

In view of the above, it is respectfully submitted that claim 8 is patentable over Walker and Woolston and that the rejection should be withdrawn.

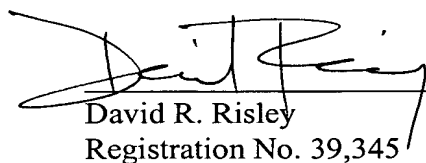
III. Canceled Claims

As identified above, claim 2 has been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicant reserves the right to present canceled claims, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

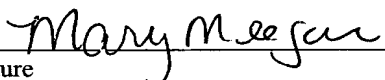
Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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10-28-04


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